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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KANESAKA AND TAKEUCHI
1423 Powhatan Street
Alexandria, VA 22314

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,506

Applicant(s)

SETO ET AL.

Examiner

Elizabeth A. Bolden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 & 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boulos et al., U.S. Patent 5,776,845.

Boulos et al. disclose a green soda-lime-silica glass having high UV absorbing properties while having a high visible transmittance. See abstract of Boulos et al and column 4, lines 38-45. The compositional ranges and visible and UV light transmittance ranges disclosed by the reference are sufficiently specific to anticipate the compositional and visible and UV light transmittance limitations in claims 1-7 and 9. See MPEP 2131.03. Furthermore, Boulos et al. discloses Examples 11-13, 17-19, and 25, which met the limitations of claim 3. See Tables IV, V, and VI. The reference further discloses Examples 20-25, which met the limitations of claims 4 and 7. See Table VI.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Boulos et al. would inherently possess the same total solar energy transmittance,

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coefficient of thermal expansion, density, and Young's Modulus as recited in claims 1 and 12.

See MPEP 2112.

Claims 1-9 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagashima et al., U.S. Patent 6,046,122.

Nagashima et al. disclose a soda-lime-silica glass having high IR and UV absorbing properties while having a high visible transmittance. See abstract of Nagashima et al., column 3, lines 27-33, and column 4, lines 47-50. The compositional ranges and the visible, total solar, and UV light transmittance ranges disclosed by the reference are sufficiently specific to anticipate the compositional and visible and UV light transmittance limitations in claims 1-9. See MPEP 2131.03. Furthermore, Nagashima et al. discloses Examples 1-3, 5, 7, and 8, which met the limitations of claims 3, 4, 5, and 7. See Table I. The reference further discloses Examples 4 and 6, which met the limitations of claims 3, 4, and 7. See Table I.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Nagashima et al. would inherently possess the same coefficient of thermal expansion, density, and Young's Modulus as recited in claims 1 and 12. See MPEP 2112.

Claims 1-9 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sakaguchi et al., U.S. Patent 5,776,846.

Sakaguchi et al. disclose a soda-lime-silica glass having high IR and UV absorbing properties while having a high visible transmittance. See abstract of Sakaguchi et al. and column 3, lines 18-22 and 26-33. The compositional ranges and visible, total solar, and UV light

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transmittance ranges disclosed by the reference are sufficiently specific to anticipate the compositional and visible and UV light transmittance limitations in claims 1-9. See MPEP 2131.03. Furthermore, Sakaguchi et al. discloses Example 2, which met the limitations of claims 3, 4, and 7. See Table 1.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Sakaguchi et al. would inherently possess the same coefficient of thermal expansion, density, and Young's Modulus as recited in claims 1 and 12. See MPEP 2112.

Claims 1-9 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagashima et al., U.S. Patent 5,858,896.

Nagashima et al. disclose a soda-lime-silica glass having high IR and UV absorbing properties while having a high visible transmittance. See abstract of Nagashima et al., column 2, lines 65-66, and column 3, lines 3-6. The compositional ranges and visible, total solar, and UV light transmittance ranges disclosed by the reference are sufficiently specific to anticipate the compositional and visible and UV light transmittance limitations in claims 1-9. See MPEP 2131.03. Furthermore, Nagashima et al. discloses Examples 1-3 and Comparative Examples 1-3, which met the limitations of claims 3-5 and 7. See Tables 1 and 2.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Nagashima et al. would inherently possess the same coefficient of thermal expansion, density, and Young's Modulus as recited in claims 1 and 12. See MPEP 2112.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al., U.S. Patent 5,112,778 in view of Boulos et al., U.S. Patent 5,776,845.

Cheng et al. teach a soda-lime-silica glass having high IR and UV absorbing properties while having a high visible transmittance. See abstract of Cheng et al. and column 7, lines 39-47, and 54-63. Cheng et al. discloses light transmittance properties for the glass composition. See column 8, lines 28-30, 33-37, and 44-46. The compositional ranges and visible and UV light transmittance ranges disclosed by the reference overlap the compositional and visible and UV light transmittance limitations in claims 3, 4, 6, and 7. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Cheng et al. differs from the instant invention by not teaching the compositional ranges of the soda-lime-silica glass.

Boulos et al. teach a soda-lime-silica glass, which anticipates the compositional limitations of claims 1 and 2. See above 35 U.S.C. 102(b) rejection.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a soda-lime-silica glass of Cheng et al. as suggested by Boulos et al. because Boulos et al. teach the compositional ranges of a soda-lime-silica glass. See column 4, lines 39-44.

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One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same coefficient of thermal expansion, density, and Young's Modulus as recited in claims 1 and 12.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 and 18-23 of copending Application No. 10/166,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositional ranges overlap. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The copending Application 10/166,064 has been allowed, once published this provisional obviousness-type double patenting rejection will become an obviousness-type double patenting rejection.

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Claims 1-9 and 12 are directed to an invention not patentably distinct from claims 14-16 and 18-23 of commonly assigned 10/166,064. Specifically, the compositional ranges overlap. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 10/166,064, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner will address the arguments as they pertain to the new rejections.

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Applicants' argue that the reference of Boulos et al., Nagashima et al. '122, Sakaguchi et al., and Nagashima et al., '896 do not disclose or teach the coefficient of expansion or the Young's modulus whereas the instant invention improves the coefficient of expansion and the Young's modulus.

These arguments surrounding the coefficient of expansion and the Young's modulus property are not deemed persuasive. MPEP 716.01(c) states:

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.

One of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same coefficient of thermal expansion and Young's Modulus as recited in the instant claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 9:30 am-7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAB
May 28, 2004


KARL GROUP
PRIMARY EXAMINER
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